

Remarks

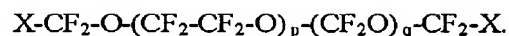
Section 112 First Paragraph Rejections

The Examiner rejected claims 1-16 under section 112 first paragraph as not being enabling because the claims extend to any lubricant while the specification only lists Z-TETRAOL as the preferred lubricant. The applicants respectfully disagree with the Examiner's application of the law of enablement in this case as will be discussed further below. However, independent claims 1 and 9 have been amended to specify that the lubricant has a linear perfluoropolyether backbone as described in the specification, and dependent claims 3-5 have been amended to specify more details about the lubricant.

The Examiner notes that applicants' summary contains the statement that "Applicants have discovered that for certain lubricants, a minimum delay time after the overcoat has been deposited and before the lubricant is applied increases the number of disks passing the glide test after abrasive polishing." The summary also includes that "the abrasive polishing should take place within a maximum time window following the application of the lubricant."

However, the specification (lines 16-25 on p. 3) also states

The preferred lubricant for use in a system according to the invention is Fomblin Z-TETRAOL which is commercially available from Solvay Solexis, Inc. It is based on a linear perfluoropolyether backbone. The functionalized versions of the "Z" family of lubricants are end capped with two functional groups specifically designed to have a strong interaction with the disk surface. The structure with end caps is given by Solvay Solexis as:



The "X" end groups for Z-TETRAOL are given as:



The applicants respectfully submit that the law of enablement does not require that applicants' claims be limited to the single lubricant mentioned in the preferred embodiment. There must be reasonable basis for questioning the adequacy of the disclosure to enable a person of ordinary skill in the art to make and use the claimed invention without resorting to undue experimentation. The applicants' specification enables the practice of the claimed method.

The Examiner cannot properly argue that applicants must limit their claims the preferred embodiment because it is clear from the applicants' specification that more than one lubricant can be used with the method. Therefore, applicants' broadest claims should cover more than one lubricant.

The specification need not describe how to make and use every embodiment of the invention because the artisan's knowledge of the prior art and routine experimentation can often fill in the gaps. (See LIEBEL-FLARSHEIM v. MEDRAD, Fed. Cir. 2007, 06-1156, 06-1157). It should also be noted that applicants are not teaching how to make the lubricant in this application. The existence of the lubricant is independent of the invention.

Both independent claims (1 and 9) as amended now include applying a linear perfluoropolyether backbone lubricant to the disk along with other steps that the Examiner has found to form a novel method. Any practitioner of the art can follow the steps without undue experimentation by applying such a lubricant.

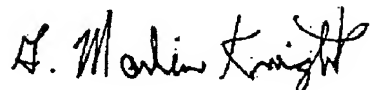
Therefore, the applicants believe that the amendments to the claims and arguments above have addressed all of the Examiner's points of rejection. Applicants submit that all of the claims in application are now allowable.

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Respectfully submitted,

A handwritten signature in black ink, appearing to read "G. Marlin Knight". The signature is fluid and cursive, with the first letters of each word being capitalized and prominent.

G. Marlin Knight (Reg. Number 33,409)

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